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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,663	11/15/2001	Michael Taylor	P00,1822 01	6719

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EXAMINER

ADE, OGER GARCIA

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,663

Applicant(s)

TAYLOR ET AL.

Examiner

Garcia Ade

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 17 recites the limitation "said maintenance business review routine" in lines 1- 2. There is insufficient antecedent basis for this limitation in the claim. It appears this claim should depend from claim 16, rather than 13. Appropriate action should be taken to correct this issue.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 7 – 19, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Discenzo [US 6,434,512].

**As per claim 1**, Discenzo discloses a method for implementation of customer-related maintenance services comprising the steps of: providing motor maintenance

services on a pro-active basis [see column 25, lines 17 – 20]; and providing modules [see column 2, lines 53 – 56] of said motor maintenance services wherein said modules are standardized and freely combinable with one another [see paragraph bridging column 2 – 3].

**As per claim 6**, Discenzo discloses the step of: providing said technical and maintenance services at a business-oriented level as well as in a technology-oriented level [column 2, lines 52 – 56 (i.e. master diagnostic module)].

**As per claim 7**, Discenzo discloses the step of: universally performing the motor maintenance services from managing, planning and coordinating the services down to operational activities with the processes implemented across all functions [via system 500, see figure 11].

**As per claim 8**, Discenzo discloses the step of: providing condition monitoring derived from a business based maintenance analysis [via signal conditioner 130, column 9, lines 13 – 29].

**As per claim 9**, Discenzo discloses the step of: providing an inventory optimization and reduction with a goal of reducing spare motors warehousing [column 28, lines 30 – 35].

**As per claim 10**, Discenzo discloses the step of: providing a shared inventory [see figure 8a (i.e. block 32, column 16, lines 16 – 39] with a goal of reducing motor inventory investment and carrying cost as well as storage, maintenance, and occupancy cost [column 2, lines 52 – 58, and column 6, lines 7 - 10].

**As per claim 11**, Discenzo discloses wherein said services are aimed to maintain motors manufactured by the service provider as well as OEM motors [.

**As per claim 12**, Discenzo discloses wherein said services include a motor upgrade [see column 2, 58 – 61 (i.e. **improved**, and replacing faulty equipment)].

**As per claim 13**, Discenzo discloses wherein said services include evaluating motors for upgrade possibilities in order to improve their functionality [column 19, lines 12 – 17, via model 530, column 21, lines 20 – 25, and via display 92, column 11, lines 56 - 58].

**As per claim 14**, Discenzo discloses wherein said services include verifying the motor reliability [column 2, lines 50 – 52 (i.e. **reliably** predict)].

**As per claim 15**, Discenzo discloses wherein said services include providing maintenance services aligned to the customer's changing business objectives [see column 25, lines 17 – 20, see paragraph bridging column 2 and 3].

**As per claim 16**, Discenzo discloses the steps of: performing a motor management review [via system 500, column 25, lines 11 – 16 (i.e. diagnostics/prognostics **evaluation** to determine what maintenance will be required to achieve)].

**As per claim 17**, Discenzo discloses wherein said motor management review routine includes: a standardized and repeatable assessment systematic on the basis of an assessment handbook [column 3, lines 14 – 28 (i.e. assessment signals)].

**As per claim 18**, Discenzo discloses the steps of: performing a motor condition assessment according to the methods of visual inspection, offline tests and online tests

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[via display 92, paragraph bridging column 7 and 8 (i.e. provides for a user to quickly *visually* access)].

**As per claim 19**, Discenzo discloses the steps of: a comparative audit including a snapshot audit at two comparative points in time, wherein the data from each snapshot audit is utilized to evaluate individual motor categories on a predetermined 1-10 scale [see column 3, lines 20 – 28 (i.e. trend analysis)].

22. A method as claimed in claim 1, wherein said steps are implemented according to the prescriptions of a service manual.

**As per claim 23**, Discenzo discloses wherein said industrial system is one of a airport, steel mill, hospital, mines, ship yard, large building, hotel, chemical plant, cement plant, subway system, railway system, container terminal, oil drilling rig or platform, paper mill, oil or natural gas pipeline system, lime plant, water treatment plant including desalination, fresh water pipelining and waste water treatment, and food service facilities [see column 25, lines 29 – 33].

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Discenzo, and further in view of Barber et al. [US 7,016,774].

**As per claims 2, 3, 21, and 22**, Discenzo discloses: performing an evaluation of a customer's technical practices and facilities regarding the motor management [via system 500, column 25, lines 11 – 16 (i.e. diagnostics/prognostics **evaluation** to determine what maintenance will be required to achieve)]; making recommendations to the customer of selected ones of said modular motor services based on results of said evaluation [via diagnostic module 50, column 12, lines 1 – 7 (i.e. **recommend** action)].

Discenzo fails to disclose providing a menu of motor services offered to the customer, said motor services being modular, performing ones of said modular motor services which are selected by the customer as outsourced services, said services being customized according to the customer's needs; providing a menu of available motor services to the customer, said menu including modular motor services available on an outsourced basis; and providing on an outsourced basis ones of said modular services selected by the customer].

However, Barber discloses a menu of motor services offered to the customer, said motor services being modular, performing ones of said modular motor services which are selected by the customer as outsourced services, said services being customized according to the customer's needs; providing a menu of available motor services to the customer, said menu including modular motor services available on an outsourced basis [column 6, lines 11 – 27, via operation 31 (i.e. a set of **menus** of service, the service menus are grouped into **sub-sets** according to vehicle type)]; and providing on an outsourced basis ones of said modular services selected by the

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customer [column 3, lines 55 – 67 (i.e. namely motor vehicle dealers 5 **appointed** by the vehicle manufacturer)].

Therefore, it would have been obvious to one of ordinary art at the time of the invention was made to modify Discenzo's invention to include Barber's invention. The motivation to combine will provide a method and system for scheduling the servicing a set of items of equipment each requiring the performance of service operations according to predetermined repair and maintenance schedules comprising compiling information relating to the items of equipment [column 2, lines 38 - 50].

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Discenzo, and further in view of Sand [US 6,512,746].

**As per claims 4 and 5**, Discenzo fails to disclose the steps of changing (valuing) compensation of said outsourced modular services depending on performance indicators; and providing said technical and maintenance services in two performance levels.

However, Sand discloses the steps of changing compensation of said outsourced modular services depending on performance indicators; and providing said technical and maintenance services in two performance levels [see abstract].

it would have been obvious to one of ordinary art at the time of the invention was made to modify Discenzo with service level agreements as taught by Sand because setting the service level agreement will provide contractual obligation guaranteed by the service provider.



9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Discenzo, and further in view of Loble et al. [US 5,844,817].

**As per claim 20**, Discenzo fails to disclose wherein each motor category is weighted according to its criticality, the weighted-score can be summarized to provide an overall motor condition evaluation, which can be compared to other points in time.

However, Loble et al. discloses wherein each motor category is weighted according to its criticality, the weighted-score can be summarized to provide an overall motor condition evaluation, which can be compared to other points in time column 6, lines 6 – 23].

It would have been obvious to one of ordinary art at the time of the invention was made to modify Discenzo with the decision system taught by Loble et al. because the DSS will allow Discenzo to determine the most critical features of the system.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571.272.6771. The fax phone

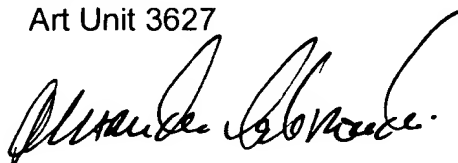
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number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ga

Garcia Ade  
Examiner  
Art Unit 3627

A handwritten signature in black ink, appearing to read 'Alexander Kalinowski', written in a cursive style.

**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**